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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,846	12/30/1998	KAZUOMI OISHI	35.G2331	2585

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EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 05/29/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/222,846

Applicant(s)

OISHI, KAZUOMI

Examiner

Douglas J. Meislahn

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,10-14,18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,10-14,18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 13 March 2003 that amended claims 1, 10, 12, 14, 18, 20, and 22 while canceling claims 4, 5, 8, and 9.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3, 6, 7, 10-14, 18-20, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 6, 10, and 12-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hickman et al. (5619025).

In the first paragraph of column 5, Hickman et al. show the use of image data as an encryption key. As detailed in their previous paragraph, this image data is collected from a document. The document reads on applicant's external source, while collection of data mandates reading means. Use of the image as an encryption key requires storage of the encryption key and encryption means to perform the actual encryption. The encrypted data is sent to an electronic database, which necessitates output means.

To insure internal security, Hickman et al. recommend immediately erasing the encryption key on completion of data transmission.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickman et al.

Hickman et al. show a key being read from an external source, used to encrypt a document, and deleted upon transmittal of the encrypted document. They do not say that the encrypted data had undergone a high-efficiency coding operation prior to encryption. Official notice is taken that it is old and well-known to subject data to high-efficiency coding operations as a way to reduce the size of the data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to subject the to-be-encrypted data in Hickman et al. to a high-efficiency coding operation in order to reduce the amount of raw data that needs to be encrypted and transmitted.

7. Claims 7, 18-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickman et al. in view of Schneier (*Applied Cryptography*).

Hickman et al. show a key being read from an external source, used to encrypt a document, and deleted upon transmittal of the encrypted document. With respect to claim 7, they do not say that the encryption key is based on a public key cryptosystem.

On page 48, Schneier teaches encrypting messages with a key based on a public key cryptosystem. This system allows anyone to have the power to encrypt, but only one entity to have the power to decrypt. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the encryption key in Hickman et al. to be a public key so that either only one entity could decrypt encrypted message or only one entity could have encrypted (by decryption) the message.

With respect to claims 18-20 and 22, they do not say that the document is actually encrypted by a second key while the key read from the external source is used to encrypt the second key. On page 176, Schneier teaches key-encryption keys and mentions that they should be distributed manually. On page 184, Schneier talks about how key-encryption keys are seldom distributed and are used to generate little ciphertext. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the keys on Hickman et al.'s external source as a key-encryption key, thus generating a minimal amount of ciphertext with the key, which reduces the benefit of replacing the key. Thus, the external source would have a longer feasible lifetime. With respect to claim 19, Schneier teaches encrypting a symmetric key with a recipient's public key on page 51; that is, the key-encryption key is from a public-key cryptosystem.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/222,846
Art Unit: 2132

Page 6



DJM
May 26, 2003

Douglas J. Meislahn
Examiner
Art Unit 2132



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